

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 17, 24, 29 and 30 are requested to be cancelled.

Claims 1, 6, 8, 18, 23 and 28 are currently being amended.

No claims are being added.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1 – 3, 6, 8 – 11, 16, 18, 23, 28 and 31 are under consideration in this application.

Item 7

On page 2 of the Office Action, the Examiner has objected to claims 6, 8 and 23 as depending from cancelled claims. Applicants have amended the aforementioned claims such that they do not depend from cancelled claims. Reconsideration and withdrawal of the objection are respectfully requested.

Item 8

On page 3 of the Office Action, the Examiner has objected to claim 17 because it allegedly fails to further limit the subject matter of claim 1. This objection is moot in light of the cancellation of claim 17. Reconsideration and withdrawal of the objection are respectfully requested.

Item 9

On page 3 of the Office Action, the Examiner has rejected a number of claims under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. Applicants address each rejection *seriatim* as it appears in the Office Action.

(A) The Examiner has rejected claim 1 because, according to the Examiner, the steps (c) “constructing a standard curve” and (d) “determining the efficacious dose based on the standard curve” recited in claim 1 allegedly lack a recitation defining the construction of the curve and the determination of the efficacious dose.

Without acquiescing to the Examiner’s position, and simply in an effort to expedite the prosecution of this application, Applicants have amended claim 1 to recite specific steps defining the construction of the curve and the determination of the efficacious dose. In particular, Applicants have added language to step (c) such that it recites the parameters that are used to construct the curve. In addition, Applicants have added language to step (d) such that it recites “an active, positive method step to carry out the claimed determination.” The language added to steps (c) and (d) may be found in the specification on page 27, lines 21 – 25.

(B) The Examiner has rejected claim 24 because there is allegedly no definition of the term “standard” in the specification.

Applicants direct the Examiner’s attention to page 13, lines 20 – 24, where the term “standard” is defined as “a known element against which an unknown element is compared and judged. This may include a single known element against which the unknown element is compared and judged. Conversely, there may be a range of known elements against which the unknown element is judged. This range of elements may be considered a standard curve.”

The specification, at page 13, lines 25 – 27 goes on to define the term “element” as “a physical characteristic that is determinable as well as a numerical or graphical value that represents what is actually determined.”

The definition of “standard” given on page 13 is supplemented in other places in the specification. In one instance, the specification at page 29, lines 12 – 21 establishes what is the “known element against which an unknown element is compared and judged.” The “known element” in the passage on page 29, lines 12- 21 is “*patients having normal angiogenic function.*” (emphasis added).

In short, claim 24 is not indefinite, since there is an adequate definition of the term “standard” in the specification. Reconsideration and withdrawal of this rejection is respectfully requested.

(C), (D) and (E) The Examiner has rejected claims 29 and 30 as allegedly being indefinite for the reasons set forth on page 3 of the Office Action. Without acquiescing to the Examiner’s position, and simply in an effort to expedite the prosecution of this application, Applicants have cancelled claims 29 and 30. In short, the rejection of these claims is now moot. Reconsideration and withdrawal of this rejection are respectfully requested.

(F) The Examiner has rejected claim 31 as allegedly being indefinite because, according to the Examiner, the terms “minimal” and “maximal” are relative terms and “the specification does not provide a standard for ascertaining the requisite degree.” Applicants respectfully traverse this rejection.

The terms “minimal” and “maximal,” as they relate to the dose, are clearly defined in the specification at page 26, lines 10 – 22. This passage provides, in relevant part, that “the efficacious dose may relate to three different points on the standard curve: the point where the curve begins to slope downward, i.e. the *minimal* efficacious dose, the point where the curve flattens out, i.e. the *maximal* efficacious dose, and the point between the *minimal* and the *maximal* dose, i.e. the IC₅₀ value.” (emphasis added). In short, claim 31 is not indefinite as a result of its recitation of the terms “minimal” and “maximal.” Reconsideration and withdrawal of this rejection are respectfully requested.

Items 10 and 11

On pages 4 - 12 of the Office Action, the Examiner rejected claims 1 - 3, 9 - 11, 16 - 18, 23, 24 and 28 - 32 under 35 U.S.C. § 103 as allegedly being rendered obvious by Tang, et al. (U.S. Patent No. 5,880,141) in view of Foulkes et al. (U.S. Patent No. 5,580,722); and Tang et al. in view of Pierce et al. (*Glycoconjugate J. 14*: 623 - 630 (1997)), and Galang et al. (*J. Biol. Chem. 271*: 7992 - 7998 (1996)).

Applicants submit that the Tang reference is not a competent reference for the purposes of an obviousness rejection under 35 U.S.C. § 103(a) since the request for a Continued Prosecution Application (CPA) was filed on April 21, 2003 and has been accepted. As the Examiner will recognize, the CPA was filed after the inception of the amendments to 35 U.S.C. § 103 under the American Inventors Protection Act (AIPA) of 1999.

As amended, 35 U.S.C. § 103(c) states:

Subject matter developed by another person, which qualifies as prior art only under subsection (e), (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Applicants assert that the claimed invention and the Tang patent were commonly owned by Sugan, Inc. at the time the claimed invention was made. In support of this assertion, Applicants submit herewith a copy of the assignment document(s) for the Tang patent, which issued from U.S. Serial No. 08/485,323, and for the instant application. Thus, under the new law, the Tang patent may not be held as prior art, under 35 U.S.C. § 103, against the claimed invention. Accordingly, reconsideration and withdrawal of the § 103 rejection is respectfully requested.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended are respectfully requested.

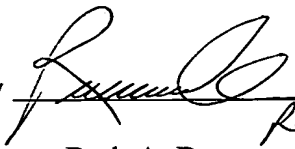
The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date February 23, 2004

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